

Amendment and Response
To Office Action Mailed April 11, 2006
For Serial No. 09/967,268

REMARKS

In the Office Action mailed April 11, 2006, the Examiner rejected claims 10-15, 17, 18, 20-30, and 32-35. By this paper, claims 10, 30, and 34 have been amended to more clearly set forth the recited subject matter. Applicant respectfully requests reconsideration of the application in view of the remarks set forth below. Applicant believes that all pending claims are in condition for allowance.

Rejections Under 35 U.S.C. § 112, first paragraph

The Examiner rejected claim 30 under U.S.C. § 112, first paragraph for failing to comply with the description requirement. More specifically, the Examiner stated:

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally presented provided no basis for a third program to be loaded into memory nor for the verifying of a third program.

Office Action, page 4.

Although the Applicant does not necessarily agree with the Examiner's rejection, the Applicant has amended claim 30 to recite "enabling a switch, wherein the second program is loaded into the storage memory only if the switch is enabled." In view of this amendment, the Applicant respectfully requests that the Examiner withdraw the rejection of claim 30 under Section 112.

Rejections Under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 10-15 under 35 U.S.C. § 102(e) as being anticipated by Nevis et al. (U.S. Patent No. 6,581,159, hereafter referred to as “the Nevis reference”). As set forth in detail below, Applicant respectfully traverses the rejection of claims 10-15.

Legal Precedent

Anticipation under Section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under Section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under Section 102, a single reference must teach each and every element or step of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Thus, if the claims contain even one recitation not found in the cited reference, the reference does not anticipate the claimed subject matter.

Independent claim 10

In rejecting independent claim 10, the Examiner stated:

Nevis teaches a host computer (Nevis, Figure 2, “Firmware”), an appliance server coupled to the host computer where the appliance server has a storage memory and an execution memory (Nevis, Figure 2 “User Mode”), a control operably coupled to the appliance server and to the storage memory to control storage of programs into the storage memory (Nevis Figure 2, Item 260, Transfer control to firmware), the appliance server being adapted to determine if a program is operable and to signal the control to permit the appliance server to storage (*sic*) a program in the

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storage memory (Nevis, Figure 2 Item 260, column 4 lines 34-56), a security device operably coupled to the control, the security device being adapted to signal the control to permit the host computer to store a program in the storage memory (Nevis, Figure 2 Item 270), and the security device being a switch (Nevis, column 5 lines 15-30, installs if hash values are correct, the act of installing occurs in response to a stimulus in the form of a correct hash comparison).

Office Action, paragraph 11. Applicant respectfully traverses the rejection.

Independent claim 10, as amended, recites, *inter alia*, “A computer system comprising...an appliance server...the appliance server being adapted to determine if a program is operable ...*and* a security device operably coupled to the control, the security device being adapted to signal the control to permit the host computer to store a program in the storage memory, the security device comprising *a switch*, wherein the program is stored in storage memory only if the switch is enabled.” (Emphasis added). Therefore, in accordance with claim 10, a program must be determined to be operable and a switch must be enabled in order to store the program in storage memory.

In contrast, the Nevis reference does not disclose installing a program only if it is determined to be operable and a switch is enabled. Applicant respectfully asserts that the Examiner has presented an inconsistent argument in this regard. Specifically, in the Examiner’s “Response to Arguments” the Examiner stated that the hash comparison of the Nevis reference is used to determine if a program is *operable*. See Office Action, paragraph 3. However, in the rejection of claim 10, the Examiner stated that the hash comparison is being used as a *switch*. See Office Action, paragraph 11. Therefore, the Examiner is

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inconsistently using the hash comparison of the Nevis reference for determining operability of a program and operating as a switch.

Indeed, the Nevis reference does not disclose a computer system comprising an appliance server adapted to determine if a program is *operable and a security device*, the security device comprising *a switch*, wherein the program is stored in storage memory only if the switch is enabled, as set forth in claim 10. Specifically, the Nevis reference discloses that a validation procedure is all that is required prior to installation of a program. *See* col. 4, line 28 to col. 5, line 37. The validation procedure may include the hash function mentioned by the Examiner and a digital signature verification. *See id.* The Nevis reference does not, however, disclose anything else as being required before installing a program. As such, the Nevis reference fails to disclose an appliance server adapted to determine if a program is *operable and a security device*, the security device comprising *a switch*, wherein the program is stored in storage memory only if the switch is enabled, as set forth in independent claim 10.

Accordingly, Applicant respectfully requests withdrawal of the rejection of claim 10 under 35 U.S.C. § 102(e), and allowance of claim 10, as well as all claims depending thereon.

Rejections Under 35 U.S.C. § 103

In the Official Action, the Examiner rejected claims 17-18, 20-23, and 24-30 under 35 U.S.C. §103(a) as being unpatentable over the Nevis reference in view of Spiegel et al. (U.S.

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Patent No. 6,711,675, hereafter referred to as “the Spiegel reference”); and rejected claims 34-35 under 35 U.S.C. §103(a) as being unpatentable over the Nevis reference in view of Holtey (U.S. Patent No. 5,491,827, hereafter referred to as “the Holtey reference”). The Applicant respectfully traverses these rejections.

Legal Precedent

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). To establish *prima facie* obviousness of a claimed invention, *all* the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974) (emphasis added). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). Additionally, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985).

Independent claim 17

In rejecting independent claim 17, the Examiner stated, “Spiegel teaches verifying a program of an appliance server (Spiegel, col. 4, lines 38-39) and if not verified, signaling a host computer to load a replacement program into the appliance server (Spiegel, col. 4, lines 40-43).” Office Action, paragraph 18. Applicant respectfully traverses the rejection.

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Independent claim 17 recites, *inter alia*, a method of operating a computer system comprising the act of “*signaling a host computer* to load a replacement program into the appliance server.” (Emphasis added).

In contrast, the Spiegel reference does not disclose a *host computer*, much less *signaling a host computer* to load a replacement program into an appliance server. The section of the Spiegel reference relied upon by the Examiner states that if the validation of a program fails, a backup BIOS startup block located in a reclaim block may be verified. Spiegel, col. 4, lines 40-43. The reclaim block is also referred to as an “update recovery block” and is merely another block of code partitioned in a firmware hub where a backup copy of the BIOS is stored. *See* Spiegel, FIG. 2; col. 3, lines, 18 through col. 4, line 29. There is no indication that the reclaim block is anything but another block of code stored in the firmware hub. There simply is nothing in the Spiegel reference that describes anything related to a *host computer*. As such, the Spiegel reference does not disclose *signaling a host computer* to load a replacement program, as set forth in claim 17.

The Nevis reference fails to obviate the deficiencies of the Spiegel reference. As such, the Nevis reference and the Spiegel reference, taken alone or in hypothetical combination, do not disclose all the elements of claim 17. Accordingly, Applicant respectfully requests withdrawal of the rejection and allowance of claim 17, as well as all claims dependent thereon.

Independent claim 24

In rejecting independent claim 24, the Examiner stated, among other things, that the Spiegel reference teaches the reloading of the first program from the execution memory into the storage memory if the second program is not verified. *See* Office Action, paragraph 24. Applicant respectfully traverses the rejection.

Claim 24 recites, *inter alia*, “A method of operating a computer system, the method comprising the acts of...executing a first program in an execution memory and having a copy of the first program stored in storage memory, replacing the first program stored in the storage memory with a second program...verifying the second program stored in the storage memory...and if not verified, reloading the first program from the *execution memory* into the storage memory.” (Emphasis added).

In sharp contrast, the Spiegel reference does not disclose reloading the first program from the *execution memory*. As discussed above, the Spiegel reference discloses saving a backup copy of a BIOS program into a partitioned portion of the firmware hub, not the *execution memory*, prior to replacement of the BIOS program. *See* Spiegel, FIG. 2; col. 3, line 18- col. 4, line 25. The firmware hub is not *execution memory*, rather it is non-volatile memory that contains code that control and validate the boot sequence. *See* Spiegel, col. 2, lines 16-18. In the event a replacement program is not verified, the backup copy in the stored in the partitioned portion of the firmware hub is verified and the system jumps to the backup copy. Spiegel, col. 4, lines 17-25, and 38-43. The Spiegel reference, therefore, does not disclose the reloading of a first program from the *execution memory* into the storage memory, as set forth in independent claim 24.

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As noted by the Examiner, the Nevis reference similarly fails to disclose reloading of the first program from the execution memory into the storage memory if verification fails. *See* Office Action, paragraph 24. Therefore, the Nevis and Spiegel references, taken alone or in hypothetical combination, fail to disclose all of the elements set forth in independent claim 24.

As such, Applicant respectfully requests withdrawal of the rejection and allowance of independent claim 24, as well as all claims depending thereon.

Independent claim 34

In rejecting independent claim 34, the Examiner cited to the Nevis and Holtey references. Although Applicant does not necessarily agree with the Examiner's rejection, claim 34 has been amended to include certain aspects. Specifically, claim 34, as amended, recites, *inter alia*, "A method of operating a computer system, the method comprising the acts of: verifying a program of an appliance server...if not verified, signaling a host computer to load a replacement program into the appliance server." Applicant asserts that, in view of the amendments, the Examiner's rejection is rendered moot. Additionally, Applicant asserts that none of the art of record discloses "signaling a host computer to load a replacement program," as set forth in claim 34.

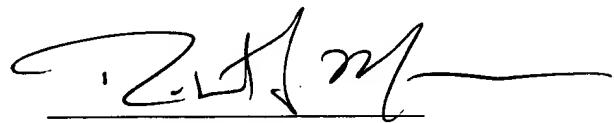
Accordingly, Applicant respectfully requests withdrawal of the rejection of claim 34, and allowance of claim 34 and all claims depending therefrom.

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Conclusion

In view of the remarks and amendments set forth above, Applicant respectfully requests allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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Date: July 11, 2006

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